

REMARKS

In the office action mailed October 5, 2005, claims 1-43 were pending for consideration. Claims 1-10, 13-34, and 37-43 were rejected on various grounds.

1. Claims 1-2, 4-7, 9-10, 13-14, 16-17, 20-34, 37, 42, and 43 were rejected under 35 U.S.C. 102(b) as anticipated by Shibuta (U.S. Patent 5,908,585).

2. Claims 1-2, 4-8, 18, 21-23, 26-30, 32-33, and 37-39 were rejected under 35 U.S.C. 102(e) as anticipated by Sheu (U.S. Patent 6,705,910).

3. Claims 1-2, 4-7, 9, 14, 16-24, 28-31, 37, 38, 42, and 43 were rejected under 35 U.S.C. 102(e) as anticipated by Glatkowski (U.S. 2003/0164427).

4. Claims 1-2, 4-7, 9, 28-31, 37, and 38 were rejected under 35 U.S.C. 102(e) as anticipated by Yaniv (U.S. 2005/0202578).

5. Claim 3 as applied to claim 2 was rejected under 35 U.S.C. 103(a) as obvious over any of Yaniv, Glatkowski, Sheu, or Shibuta further in view of Shibuta with Friend (U.S. Patent 5,098,771).

6. Claim 8 was rejected under 35 U.S.C. 103(a) as obvious over any of Yaniv, Glatkowski, Sheu, or Shibuta further in view of Eklund (U.S. Patent 6,139,919).

7. Claim 41 was rejected under 35 U.S.C. 103(a) as obvious over Yaniv.

In addition, the Examiner indicated that Claims 11-12 and 35-36 would be allowable if rewritten in independent form. Applicant appreciates the indication of allowable subject matter in the present application. Each of the Examiner's rejections is addressed in turn below.

Amendments and Support

Claims 9, 10, 24 and 35 have been canceled. Applicant has amended Claims 1, 11-13, 21, 25, 28, 36, and 41-43 to include the subject matter of one or more claims which were indicated as allowable, including intervening claim limitations, or to include subject matter which is substantially similar to matter indicated as allowable. No new matter is added by these amendments and the Applicant reserves the right to pursue canceled or relinquished subject matter in future applications. Therefore, upon entry of this amendment, Claims 1-8, 11-23, 25-34 and 36-43 remain pending.

Claims 1, 21, 25, and 41-43 were amended to include the limitation of “a stabilizing agent configured to inhibit agglomeration of the plurality of nanostructures, said stabilizing agent being a nanostructure surface attached ligand, nanostructure polymeric coating, metal coating, semimetal oxide coating, or metal oxide coating.” Support for this phrase can be found in allowed Claims 9, 11 and 12, as well as the filed specification at page 9, lines 16-19, 25 and page 10, lines 20-23. It is noted that the language used in the specification is alternative language with the connecting term “or.” See page 9, line 18. Further, each class of stabilizing agents is individually discussed and identified in the above recited passages. In addition, the exclusion of the class “surfactants” should not be read to limit the scope of available equivalents to the remaining classes of stabilizing agents under the doctrine of equivalents for these claims.

Claim 13 was amended to specifically claim nanostructure polymeric coatings instead of nanostructure surfactant coatings. Support for this amendment can be found at page 9, lines 16-19 and 25 of the originally filed specification.

Claims 11, 12 and 36 were amended to change the claim dependency in light of the amendment of the intervening claims into the respective independent claims and cancellation thereof.

Independent Claim 28 was amended to include the allowable subject matter of Claim 35 per the suggestion of the Examiner and should now be allowable.

Rejections under 35 U.S.C 102(b)

The Examiner has rejected Claims 1-2, 4-7, 9-10, 13-14, 16-17, 20-34, 37, 42, and 43 under 35 U.S.C. 102(b) as anticipated by Shibuta. Claim 28 has been amended to include the allowable subject matter of Claim 35, and Claims 29-34 and 37 depend from Claim 28. Therefore, allowance of these claims is respectfully requested.

Further, Applicant has amended each of independent claims 1, 21, and 41-43 to include specific classes of stabilizing agents which encompass the allowed subject matter of Claims 11 and 12. In particular, the stabilizing agents are “configured to inhibit agglomeration of the plurality of nanostructures” and include a “nanostructure surface attached ligand, nanostructure polymeric coating, metal coating, semimetal oxide coating, or metal oxide coating.” None of these stabilizing agents are taught by Shibuta. Therefore, these rejections based on Shibuta should be withdrawn.

Rejections under 35 U.S.C 102(e)

The Examiner has rejected Claims 1-2, 4-8, 18, 21-23, 26-30, 32-33, and 37-39 under 35 U.S.C. 102(e) as anticipated by Sheu. Claims 29-30, 32-33 and 37-39 depend from Claim 28 which has been amended to include the allowable subject matter of Claim 35. Therefore, the rejection of these claims should be withdrawn.

Applicant has also amended each of independent claims 1, 21, and 41-43 to include specific classes of stabilizing agents as recited above with respect Shibuta. Sheu fails to teach stabilizing agents of any kind for nanostructures and therefore fails to teach each and every element of the claimed invention. Therefore, Applicant respectfully requests that the rejections based on Sheu be withdrawn.

The Examiner has rejected Claims 1-2, 4-7, 9, 14, 16-24, 28-31, 37, 38, 42, and 43 under 35 U.S.C. 102(e) as anticipated by Glatkowski. As mentioned above, Claim 28 has been amended to include allowable subject matter and Claims 29-31, 37 and 38 depend from Claim 28. Therefore, these claims should now be considered allowable.

Further, Applicant has amended each of independent claims 1, 21, and 41-43 to include specific classes of stabilizing agents. In particular, the stabilizing agents are “configured to inhibit agglomeration of the plurality of nanostructures” and include a “nanostructure surface attached ligand, nanostructure polymeric coating, metal coating, semimetal oxide coating, or metal oxide coating.” None of these stabilizing agents are taught by Glatkowski. Thus, Glatkowski fails to teach each and every element of the claimed invention. Therefore, these rejections based on Glatkowski should be withdrawn.

The Examiner has also rejected Claims 1-2, 4-7, 9, 28-31, 37, and 38 under 35 U.S.C. 102(e) as anticipated by Yaniv. Again, Claims 28-31, 37 and 38 all include the limitations of allowable Claim 35. Therefore, the rejections of these claims should be withdrawn.

In addition, independent Claim 1 (from which the remainder of the rejected claims depend) has been amended to include specific classes of stabilizing agents. In particular, the stabilizing agents are “configured to inhibit agglomeration of the plurality

of nanostructures” and include a “nanostructure surface attached ligand, nanostructure polymeric coating, metal coating, semimetal oxide coating, or metal oxide coating.”

None of these stabilizing agents are taught by Yaniv. Thus, Yaniv fails to teach each and every element of the claimed invention. Therefore, Applicant respectfully requests that these rejections based on Yaniv be withdrawn.

Rejections under 35 U.S.C. 103(a)

The Examiner has also rejected Claims 3, 8 and 41 under 35 U.S.C. 103(a) over any of Yahiv, Glatkowski, Sheu, or Shibuta further in view of Shibuta with Friend or further in view of Eklund. Claims 1 and 41 have been amended to include specific classes of stabilizing agents as discussed above. None of these references either teaches or suggests the claimed types of stabilizing agents. Therefore, these rejections should be withdrawn and allowance of these claims would be appreciated. Conclusion

In view of the foregoing, Applicant respectfully submits that Claims 1-8, 11-23, and 25-43 are now in a condition for allowance. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be resolved during a telephone interview, the Examiner is invited to telephone Sue Heminger at (650) 236-2738 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment
to Deposit Account No. 08-2025

Dated this 5th day of January, 2006.

Respectfully submitted,



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